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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/762,530      | 05/15/2001  | Reto Sieber          | F 6817              | 5031             |

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02/08/2005

Jordan and Hamburg  
122 East 42nd Street  
New York, NY 10168

EXAMINER

AHMAD, NASSER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/762,530

Applicant(s)

SIEBER ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 26, 2004 has been entered.

### ***Specification***

2. The substitute specification submitted with the request for continued examination (RCE) on November 26, 2004 has been received and entered into the application.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal (GB: 2063710).

Marchal relates to a self-adhesive sheet (see figure-3) consisting of a backing layer (11) having a top surface and a bottom surface, a first pressure sensitive adhesive (PSA) (11A1) coating coated on the top surface of said backing and the coated top surface being planar, and a second PSA (11B) coating coated on the bottom surface of the

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backing layer and the coated bottom surface being planar. The backing layer comprises a polymer film or a textile sheet arranged on the top surface of the backing such as when treated to make it impermeable (page-2, lines 116-119). The textile structure would include weave of intersecting threads and hence, a meshed arrangement. The different adhesive pattern provided on the top surface and the bottom surface would provide for different adhesive strengths of the two PSAs. As shown in figure-1, the adhesive sheet has a removable covering (2 or 3) on the adhesive. The self-adhesive sheet has a certain width dimension. However, Marchal fails to teach that the minimum width of the sheet is 350 mm. It would have been obvious to one having ordinary skill in the art to modify Marchal by providing its adhesive sheet to have a width of at least 350 mm, based on optimization through routine experimentation, as the reference is also directed to same filed of bonding floor covering to a floor as in the instant application and the coverage extent would be obvious optimization.

Marchal also relates to a method for bonding a floor covering to a floor comprising adhering the bottom surface of the adhesive sheet to a floor and adhering a floor covering to the top surface of the adhesive sheet (page-1, lines 5-12), wherein the floor covering can be a carpet.

As for the particular textile meshed arrangement as claimed in claim 14, it would have been obvious to one having ordinary skill in the art to modify Marchal by providing said mesh arrangement shape because it would have involved a mere change in the shape of a component. A change of shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ47 (CCPA 1976).

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Regarding the particular textile structure thread spacing of 3 to 30 mm, it would have been obvious to modify the textile mesh structure of Marchal to have the thread spacing of 3 to 30 mm, based on optimization through routine experimentation, to provide optimum structure to the backing layer.

The adhesive strength of the adhesive layers are different because of the different application, in that the layer (11A1) has a patterned coat which would exhibit a strength lower than that of the lower coat (11B) and the strength of 0.8 to 5 N (claims 14 and 22-23) would have been obvious based on optimization through routine experimentation.

The application rate of the adhesive in claims 19 and 24 have not been given any patentable weight because the process conditions are not germane to the issue of patentability of the product itself.

5. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal in view of Su (5462782).

Marchal, as discussed above, fails to teach that the backing layer polymer can be polyethylene. Su discloses a double-sided adhesive tape comprising a backing layer of polyethylene (abstract) to provide for strength to the structure. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Su's teaching of using a polyethylene backing as the backing layer in the invention of Marchal with the motivation to provide strength to the tape structure.

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As for the floor covering being parquet, Marchal broadly teaches floor covering which would include all flooring material such carpet and parquet. Hence, it would have been obvious to use floor covering of carpet or parquet, as said floor covering material are deemed to be functionally equivalent and use of one for the other would have been obvious to one having ordinary skill in the art.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marchal. Marchal, as discussed above, fails to teach that the self-adhesive sheet comprises a second textile structure arranged on the bottom surface thereof. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for the second textile structure on the bottom surface thereof for enhancing the reinforcing strength to the sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

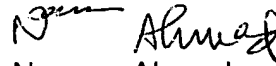
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
January 31, 2005.